

REMARKS/ARGUMENTS

Claims 1-11, 15-39, 43-67, 71-126 are pending in the application. Claims 1-4, 6, 7, 11, 15, 16, 18, 21, 24-32, 34, 35, 39, 43, 44, 46, 49, 52-60, 62, 63, 67, 71, 72, 74, 77, 80-87, 90, 99-101, 104, 113-115, and 118 are amended, claims 19, 23, 47, 51, 75, and 79 are cancelled. The amendments to the claims as indicated herein do not add any new matter to this application. Furthermore, amendments made to the claims as indicated herein have been made to exclusively improve readability and clarity of the claims and not for the purpose of overcoming alleged prior art.

Applicant thanks the Examiner for his comments during a September 4, 2008 telephone interview.

I. CLAIM REJECTIONS—35 U.S.C. § 103

The Office Action rejected Claims 1-5, 8-9, 15-33, 36-37, 43-61, 64-65, 71-90, 93-104, 107-118 and 121-126 under 35 U.S.C. § 103(a) as being unpatentable over Ismail, (U.S. Pat # 6,614,987), in view of Rosin, (U.S. Pat # 6,028,600), and Schein (U.S. Patent # 5,801,787) and further in view of Emura (U.S. Patent #6,344,878). The rejection is respectfully traversed.

Claims 1, 29, and 57:

Claim 1 has been amended to add elements of Claims 6 and 23, and appears as follows:

1. (Currently Amended) A process for scheduling recording, storing, and deleting of television and/or Web page program material on a storage medium in a computer environment, comprising:
 - generating a prioritized list of program viewing preferences;
 - wherein said list contains a viewer's explicit preferred program selections for recording and inferred preferred program selections for recording;
 - comparing said list with a database of program guide objects;

wherein said program guide objects indicate when programs of interest are broadcast;

generating a schedule of time versus available storage space that is optimal for the viewer's explicit or inferred preferred programs using said database of program guide objects, said schedule of time versus available storage space tracks all stored programs and programs that have been scheduled to be recorded in the future;

wherein said explicit and inferred preferred programs include television broadcast programs and/or Universal Resource Locators (URLs);

generating an ordered list of future showings of a specific program of interest using said database of program guide objects; and

checking showing(s) of said specific program of interest in said ordered list for input source or storage space conflicts with programs previously scheduled for recording using said schedule of time versus available storage space until a particular showing of said specific program of interest is found having no input and/or space conflicts for the time the particular showing is available such that a recording of said specific program of interest is made as soon as possible and scheduling said particular showing of said specific program of interest for recording;

wherein said checking step makes a determination of conflicts for an explicitly selected program immediately upon the viewer making the explicit selection of the program to record.

In particular, Ismail does not teach or disclose generating a schedule of time versus available storage space that is optimal for the viewer's explicit or inferred preferred programs using said database of program guide objects, said schedule of time versus available storage space tracks all stored programs and programs that have been scheduled to be recorded in the future as cited in Claim 1. Addressing the Office Action's comments regarding Claim 6, the Office Action states:

"Ismail teaches managing the capacity of storage devices 106 at the user's terminal, which includes detecting the programs already stored and those scheduled to be recorded at a particular time, col. 10, lines 9-14."

However, Ismail does not teach what the Office Action states. Ismail simply checks how much space is available on the storage devices 106 to make his determination if a program is to be recorded. If there is no room on the storage devices, Ismail's system does not record that program. Ismail in col. 10, lines 9-14 states:

“The recordation is subject to storage capacity constraints. For example, if the highest rated program is one-hour long, and only thirty minutes of recording space is available on storage devices 106, then the one-hour program is skipped and the highest rated thirty-minute program is recorded.”

It is clear from Ismail that his system only checks if there is enough available space for the program and if sufficient space does not exist, he simply skips to the next program that requires the amount of space available and records that next program.

Therefore, Ismail does not contemplate generating a schedule of time versus available storage space that is optimal for the viewer’s explicit or inferred preferred programs using said database of program guide objects, said schedule of time versus available storage space tracks all stored programs and programs that have been scheduled to be recorded in the future. Ismail makes no mention of such features and further, teaches away from such features by teaching that his system simply checks to see how much recording space is available on his storage devices.

Additionally, Ismail does not teach or disclose generating a schedule of time versus available storage space that is optimal for the viewer’s explicit or inferred preferred programs using said database of program guide objects, said schedule of time versus available storage space tracks all stored programs and programs that have been scheduled to be recorded in the future as cited in Claim 1. The Office Action points to col. 2, lines 1-34, col. 9, lines 59-67, and col. 10, lines 1-40. However, as discussed above, Ismail only discloses that his system only checks if there is enough available space for the program and if sufficient space does not exist, he simply skips to the next program that requires the amount of space available and records that next program.

Ismail’s disclosure makes no mention of said schedule of time versus available storage space tracks **all stored programs and programs that have been scheduled to be recorded in the future** as cited in Claim 1. Ismail teaches away from such features by teaching that when a

program is to be recorded at a certain time, if there is insufficient amount of storage available on the storage devices at the time his system checks the storage devices, the program is not recorded and his system skips to the next program that requires the amount of storage available and records that next program.

Therefore, Ismail does not contemplate generating a schedule of time versus available storage space that is optimal for the viewer's explicit or inferred preferred programs using said database of program guide objects, said schedule of time versus available storage space tracks all stored programs and programs that have been scheduled to be recorded in the future.

Ismail further does not teach or disclose generating an ordered list of future showings of a specific program of interest using said database of program guide objects and checking showing(s) of said specific program of interest in said ordered list for input source or storage space conflicts with programs previously scheduled for recording using said schedule of time versus available storage space until a particular showing of said specific program of interest is found having no input and/or space conflicts for the time the particular showing is available such that a recording of said specific program of interest is made as soon as possible and scheduling said particular showing of said specific program of interest for recording as cited in Claim 1. The Office Action points to Schein and states:

“However, Schein teaches providing a list of future showings of a particular program of interest, see Fig. 3, col. 6, lines 1-52. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Ismail with the feature of providing a list of future showings of a program of interest, as taught by Schein, at least for the desirable purpose of enabling the customer, see col. 1, lines 55-67 thru col. 2, lines 1-10 to purchase and/or view a desired program at the most convenient time for the customer.”

The Office Action has cited Schein to teach that a user selects a show from a program guide and Schein's system displays any other occurrences of the show to a user where the user manually selects a show from the display (col. 5, line 38-col. 6, line 52). Note that, as the Office

Action points out, this is a display that requires the user to manually scan and select an item from the list. The Office Action's statement shows that Schein has been cited out of context of the feature cited in Claim 1. Claim 1 further cites checking showing(s) of said specific program of interest in said ordered list for input source or storage space conflicts with programs previously scheduled for recording using said schedule of time versus available storage space until a particular showing of said specific program of interest is found having no input and/or space conflicts for the time the particular showing is available such that a recording of said specific program of interest is made as soon as possible and scheduling said particular showing of said specific program of interest for recording.

The Office Action then states:

“The additionally claimed feature of, ‘checking each showing of space and input source conflicts, and only reco[r]ding the programs without conflicts’, reads on the above cited teachings of Ismail, (col. 10, lines 1-14), as applied to Schein, which teaches ‘future showings of a program of interest’.”

First, the Office Action has misquoted the features cited in Claim 1. The Office Action has cited features in Claim 1 that are out of context. The claimed feature is “checking showing(s) of said specific program of interest in said ordered list for input source or storage space conflicts with programs previously scheduled for recording using said schedule of time versus available storage space until a particular showing of said specific program of interest is found having no input and/or space conflicts for the time the particular showing is available such that a recording of said specific program of interest is made as soon as possible and scheduling said particular showing of said specific program of interest for recording”.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)(MPEP 2143.03).

Second, the Office Action has also misquoted Schein as teaching “future showings of a program of interest” and has presented Schein in a manner excluding the parts of Schein that are important to give context to Schein’s teachings. The Applicants respectfully note, that the prior art must be considered as a whole. *W.L. Gore & Associates v. Garlock*, 721 F.2d 1540, 1550 (Fed Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). “It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In Re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986).

Third, following the Office Action’s rationale, Ismail’s system would generate a display as taught in Schein to display other occurrences of a show to a user where the user manually selects a show from the display and then a preference agent would eventually check for available space on the storage drives at the time the manually selected program is to be recorded and if there is insufficient amount of storage available on the storage devices at the time Ismail’s system checks the storage devices, the manually selected program is not recorded and Ismail’s system skips to a next program that is to be recorded at that time that requires the amount of storage available and records that next program. This is not what is cited in Claim 1.

Therefore, it would **not** have been obvious for one of ordinary skill in the art at the time the invention was made to modify Ismail with the feature of providing a list of future showings of a program of interest, as taught by Schein, as the Office Action posits because Ismail would not

have done anything differently when recording a program and deciding whether there was sufficient amount of storage available to record the program.

Given that Ismail and Schein do not teach or disclose generating an ordered list of future showings of a specific program of interest using said database of program guide objects and checking showing(s) of said specific program of interest in said ordered list for input source or storage space conflicts with programs previously scheduled for recording using said schedule of time versus available storage space until a particular showing of said specific program of interest is found having no input and/or space conflicts for the time the particular showing is available such that a recording of said specific program of interest is made as soon as possible and scheduling said particular showing of said specific program of interest for recording, adding Emura is ineffectual because Emura discusses rescheduling recordings that overlap in time only.

The Office Action further states that the combination of references do not go into such detail as described in Claim 1, namely, checking showing(s) of said specific program of interest in said ordered list for input source or storage space conflicts with programs previously scheduled for recording using said schedule of time versus available storage space until a particular showing of said specific program of interest is found having no input and/or space conflicts for the time the particular showing is available such that a recording of said specific program of interest is made as soon as possible and scheduling said particular showing of said specific program of interest for recording. Therefore, Ismail as applied to Schein and Emura do not teach or disclose such features.

Finally, as discussed with the Examiner during the above-cited telephone interview, neither of the cited references teach or disclose checking showing(s) of said specific program of interest in said ordered list for input source or storage space conflicts with programs previously scheduled

for recording using said schedule of time versus available storage space until a particular showing of said specific program of interest is found having no input and/or space conflicts for the time the particular showing is available such that a recording of said specific program of interest is made as soon as possible and scheduling said particular showing of said specific program of interest for recording, wherein said checking step makes a determination of conflicts for an explicitly selected program immediately upon the viewer making the explicit selection of the program to record as cited in Claim 1. Neither Ismail, nor Schein, nor Emura make any mention of such features. Therefore, Ismail, Schein, and Emura do not contemplate such features.

With regard to Claims 15, 43, and 71, Applicants respectfully traverse the Official Notice and request a showing of support for the Official Notice taken.

With regard to Claims 16, 26, 44, 54, 72, 82, 96-97, 110-111, and 124-125, Applicants respectfully traverse the Official Notice and request a showing of support for the Official Notice taken.

With regard to Claims 26, 54, and 82, Applicants respectfully traverse the Official Notice and request a showing of support for the Official Notice taken.

With regard to Claims 22-23, 50-51, and 78-79, Applicants respectfully traverse the Official Notice and request a showing of support for the Official Notice taken.

With regard to Claims 24, 52, and 80, Applicants respectfully traverse the Official Notice and request a showing of support for the Official Notice taken.

Therefore, Ismail in view of Rosin and Schein and further in view of Emura does not teach or disclose the invention as claimed.

Claim 1 is allowable. Claims 29 and 57 are allowable in similar manner. Claims 2-5, 8-9, 15-28, and 30-33, 36-37, 43-56, and 58-61, 64-65, 71-84, are dependent upon independent Claims 1, 29, and 57, respectively. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

Claims 85, 99, and 113:

Claim 85 has been amended to clarify the claimed invention and appears as follows:

85. A process for scheduling recording, storing, and deleting of television and/or Web page program material on a storage medium, comprising:

- deriving an ordered list of future showings of a specific program of interest from a database of program guide objects;

- wherein said program guide objects indicate when programs are broadcast or transmitted;

- determining storage medium memory space and input source scheduling conflicts between showings of said specific program of interest in said ordered list and programs that have been scheduled to be recorded in the future, the determining step checking a plurality of input sources for input sources appropriate for each showing of said specific program of interest in said ordered list;

- wherein said programs that have been scheduled to be recorded in the future comprise a viewer's explicit program selections and inferred program selections; and

- scheduling for recording a particular showing of said specific program of interest that is found having no memory space and/or input conflicts such that a recording of said specific program of interest is made as soon as possible.

Ismail in view of Rosin and Schein and Emura does not teach or disclose determining storage medium memory space and input source scheduling conflicts between showings of said specific program of interest in said ordered list and programs that have been scheduled to be recorded in the future, the determining step checking a plurality of input sources for input sources appropriate for each showing of said specific program of interest in said ordered list as cited in Claim 85. As shown above, Ismail discloses that when a program is to be recorded at a certain time, if there is insufficient amount of storage available on the storage devices at the time his

system checks the storage devices, the program is not recorded and his system skips to the next program that requires the amount of storage available and records that next program. Schein lets the user select another program from a display. Emura reschedules recordings that overlap in time.

Therefore, neither cited reference, alone or in combination, teach or disclose determining **storage medium memory space and input source** scheduling conflicts between showings of said specific program of interest in said ordered list and programs that have been scheduled to be recorded in the future, the determining step **checking a plurality of input sources for input sources appropriate for each showing of said specific program of interest in said ordered list**.

Therefore, Ismail in view of Rosin and Schein and further in view of Emura does not teach or disclose the invention as claimed.

Claim 85 is allowable. Claims 99 and 113 are allowable in similar manner. Claims 86-90, 93-98, and 100-104, 107-112, and 114-118, 121-126, are dependent upon independent Claims 85, 99, and 113, respectively. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

II. CLAIM REJECTIONS—35 U.S.C. § 103

The Office Action rejected Claims 6-7, 10-11, 34-35, 38-39, 62-63, 66-67, 91-92, 105-106, 119-120, under 35 U.S.C. § 103(a) as being unpatentable over Ismail, Rosin, Schein, Emura, in view of Wood (U.S. PG PUB 2002/0054752 A1). The rejection is respectfully traversed.

The rejection under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments regarding Claims 1, 29, 57, 85, 99, and 113, above. Claims 6-7, 10-11, and 34-35, 38-39, and

62-63, 66-67, and 91-92, and 105-106, and 119-120, are dependent upon independent Claims 1, 29, 57, 85, 99, and 113, respectively. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

III. CONCLUSION

Applicants respectfully requests that a timely Notice of Allowance be issued in this case.

The Applicants believe that all issues raised in the Office Action have been addressed and that allowance of the pending claims is appropriate. Entry of the amendments herein and further examination on the merits are respectfully requested.

The Examiner is invited to telephone the undersigned at (408) 414-1214 to discuss any issue that may advance prosecution.

To the extent necessary, Applicants petition for an extension of time under 37 C.F.R. § 1.136. The Commissioner is authorized to charge any fee that may be due in connection with this Reply to our Deposit Account No. 50-1302.

Respectfully submitted,

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